



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/901,692	07/28/97	KAMAKURA	A 1095.1076/JD

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LM71/0118

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2765

DATE MAILED: 01/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

08/901,692

Applicant(s)

Kawasaki-Shi et al.

Examiner

Hani Kazimi

Group Art Unit

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**THE PERIOD FOR RESPONSE:** [check only a) or b)]

- a) ☒ expires 5 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Nov 8, 1999 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Nov 8, 1999 has been considered with the following effect, but is **NOT** deemed to place the application in condition for allowance:

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☐ will not be entered because:
    - ☐ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does **NOT** place the application in condition for allowance because:  
See attached.
- ☐ The affidavit or exhibit will **NOT** be considered because it is not directed **SOLELY** to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: \_\_\_\_\_
- Claims objected to: \_\_\_\_\_
- Claims rejected: 1-14
- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Other PTO 892 (Notice of references cited)

ERIC W. STAMBER  
PRIMARY EXAMINER

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**RESPONSE TO REQUEST FOR RECONSIDERATION**

1. This communication is responsive to the request for reconsideration (petition under 37 CFR 1.181), filed on November 8, 1999.

***Time line of Prosecution of the Instant Application***

11/25/98: First Office Action issued includes rejection under 35 U.S.C. 103(a) as being unpatentable over Fraser in view of Lalonde et al. Rejection of claim 2 includes Official Notice rejection that it is old and well known in the art to "seek prior approval ...".

3/25/99: Applicant's response to the first Office action included arguments that "it would not have been obvious to one having ordinary skill in the art to have been realistically motivated to modify the Fraser and Lalonde et al. references with the Official Notice." and that "while the Examiner may argue (take Official Notice) that it is well known to determine whether prior approval by the consumer is required, even assuming *arguendo* this to be true, there is no motivation to use this 'determination' in combination with the existing 'goods and services' products disclosed in Fraser and Lalonde et al.".

6/7/99: Final rejection issued includes rejection under 35 U.S.C. 103(a) as being unpatentable over Fraser in view of Lalonde et al. Rejection of claim 2 includes Official Notice

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rejection that it is old and well known in the art to “seek prior approval ...” (i.e., the Examiner has maintained the rejection previously set forth in the first Office action).

9/7/99: Applicant filed a first Request for Reconsideration which included arguments that “Although the same references were used to reject the claims in the November 25, 1998 and June 7, 1999 Office Actions, the comments in the June 7, 1999 Office Action were different from the comments in the first Office Action in several ways. For Example, ‘Official notice’ was taken regarding teachings allegedly ‘well known in the art’.” Additionally, Applicant requested that the Examiner cite a reference in support of these Official Notice statements.

9/23/99: Advisory action was issued, and in response to the challenge of Official Notice, the Examiner stated that the challenge was not “seasonable”.

11/8/99: Applicant filed petition under 37 CFR 1.181 which is being treated as a second request for reconsideration, and is discussed in detail below.

### *Response to Arguments*

2. In the second request for reconsideration (petition), Applicant argues that the Examiner should have provided a reference in response to their challenge of the Official Notice filed 9/7/99.

However, it is clear from the Time line of events surrounding the prosecution of the

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instant application set forth above that Applicant **did not** “seasonably” challenge the Examiner’s taking of Official Notice. It is clear that the Examiner took Official Notice as far back as the first Office Action (mailed 11/25/98) and no challenge was presented in the response to the first Office Action filed 3/25/99. It is clear from reading the response to the first Office Action that Applicant had no specific problem with the Examiner’s taking of Official Notice (Applicant did not request that a reference backing-up the Official Notice to be cited). Instead Applicant argued that the combination of Fraser, Lalonde et al. and Official Notice did not teach all of the claimed limitations. It was only after the Examiner maintained the Official Notice and made the rejection final that Applicant changed their point of argument and requested a reference in support of the Official Notice.

“If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next response after the Office Action in which the well known statement was made.” (See MPEP 2144.03).

3. In an effort to advance prosecution, three references are being supplied on the cited PTO-892 (Notice of References Cited) attached to this advisory action and listed below. However, the period of response is **not** being restarted and continues to run 2 months from the filing of the Notice of Appeal filed 11/8/99. The following references are cited on the cited PTO-892 (Notice

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of References Cited):

- a) Ryder, Sr. et al. US Patent 4,953,209, Aug. 28, 1990 (column 1, lines 15 thru 27).
- b) DiRienzo US Patent 6,003,007, Dec. 14, 1999 (column 4, line 66 thru column 5, line 8).
- c) Clinton, Wilder, "E-Commerce Emerges", Information Week, v584 p14(2), June 17, 1996.

*Conclusion*

4. Any inquiry concerning this statement or earlier statements from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached on Monday - Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners' supervisor, Allen MacDonald, can be reached at (703) 305-9708. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi.

January 10, 2000